

REMARKS

In response to the Office Action dated June 25, 2008, Applicant respectfully submits that the Examiner has failed to follow the correct procedure upon reversal of the rejection of claim 20 by the Board. According to the MPEP at Section 1214.06:

If the Board affirms a rejection against independent claim 1, reverses all rejections against dependent claim 2 and claim 3 is allowed . . . the examiner should either:

- (A) Convert dependent claim 2 into independent form by examiner's amendment, cancel claim 1 in which the rejection was affirmed, and issue the application with claims 2 and 3; or
- (B) Set a 1-month time limit in which appellant may rewrite dependent claim 2 in independent form.

(emphasis added). Here, the Board "affirm[ed] a rejection against independent claim 1," but reversed the rejection of dependent claim 20. Hence, instead of issuing the instant Action, the Examiner should have followed one of the two alternatives provided (especially since the rejection in the present Action has previously been made and withdrawn). Nonetheless, Applicant presents the foregoing amendment to claim 1 to incorporate the limitations of claim 20 into claim 1 to effect this result.

As for the current anticipation rejection of claim 20 made in the Action based on Nagata et al., it cannot stand. The law is clear that anticipation requires the presence of each and every element of the claim is found in the four corners of the reference. *See Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (holding that an anticipating reference must describe all claimed aspects of the invention).

In the Office Action, the Examiner expressly admits that "Nagata et

el. discloses the claimed invention except for that the average diameter of the fibers is between 18 - 22 microns.” (Office Action, June 25, 2008, paragraph bridging pages 4-5). If the Examiner’s statement is true, it necessarily follows, as a matter of law, that Nagata et al. cannot anticipate the invention of claim 1.

Regardless, Nagata et al. also does not expressly describe crystalline/semi-crystalline high melt bi-component fibers. The Examiner’s position appears to be that this is an inherent feature of all fibers. For a rejection to be proper based on “inherency,” the missing claim feature must necessarily be present in the reference. *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282, 54 USPQ2d 1673 (Fed. Cir. 2000) (“a prior art reference may anticipate without disclosing a feature of the claimed invention if that missing feature is *necessarily present . . .*”) (emphasis added). Consequently, the mere probability or possibility that the claimed invention might result under certain circumstances is insufficient. *Continental Can Company USA v. Monsanto Company*, 948 F.2d 1264, 1269, 20 USPQ2d 1746 (Fed. Cir. 1991) (“Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”). *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597 (Fed. Cir. 2002). *See also W.L. Gore v. Garlock, Inc.*, 721 F.2d at 1554 (Fed. Cir. 1983) (anticipation “cannot be predicated on mere conjecture respecting the characteristics of products . . .”); *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (CCPA 1982) (to anticipate, the asserted inherent function must be present in the prior art).

In the instant situation, no substantial evidence or convincing line of reasoning explains why it is “necessarily” the case that Nagata et al.

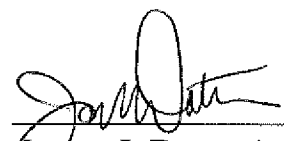
discloses the claimed arrangement of fibers. In the Action, the Examiner contends that Nagata et al. anticipates the invention of claim 20, stating that “it should be noted the bicomponent CoPET/PET fibers are considered to be at least some level of crystalline or semicrystalline as they are able to maintain a fiber form” (Office Action on June 25, 2008, page 4, lines 5-7).

Respectfully, this is pure speculation on the part of the Examiner, unsupported by any evidence or convincing line of argument. The statement made in support of the rejection disregards the existence of amorphous (e.g., non-crystalline) fibers, which “maintain a fiber form” despite neither being crystalline or semi-crystalline. Indeed, Applicant notes that each and every example provided in Nagata et al. uses amorphous (that is, non-crystalline or semi-crystalline) fibers. *See, e.g.*, col. 7, lines 7 and 10). In light of the foregoing, reversal of the rejections of claim 1 and its progeny is in order.

Applicant also presents new claims 30-35. Claim 30 requires the crystalline/semi-crystalline high melt bicomponent fibers, and is thus allowable over Nagata et al. for the foregoing reasons. It follows that dependent claims 31-35 are likewise allowable.

Upon reconsideration of the rejections, it is believed the examiner will agree that the inventions as set forth in independent claims 1 and 30 patentably distinguish over Nagata et al. Accordingly, all the claims remaining in the application are in condition for allowance, and reconsideration of the decision to reject these claims finally is respectfully requested. Any fees required in connection with this Response may be debited to Deposit Account 50-0568.

Respectfully submitted,



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